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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,483	05/09/2001	Daniel Wildmann	2821-205WOUS	5565

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Hartford, CT 06103-4102

EXAMINER

ELVE, MARIA ALEXANDRA

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/831,483

Applicant(s)

WILDMANN ET AL.

Examiner

M. Alexandra Elve

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-22, 29, 34 and 35 is/are allowed.
- 6) ☒ Claim(s) 11, 23, 24, 27, 28, 30, 33, 36-38 and 40 is/are rejected.
- 7) ☒ Claim(s) 25, 26, 31, 32, 39, 41 and 42 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11, 23-24, 27-28, 30, 33, 36-38 & 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitahama et al. (US Pat. 5,217,155) in view of Bischofberger et al. (US Pat. 5,290,990).

Kitahama et al. discloses the joining of sheet material. Plastic deformation occurs between the end portions of leading and trailing pieces. End portions are brought into contact with each other due to metal flow, forming a gap portion between the sheet materials (abstract). Pressing rolls are used (see figure 1 article 5) (col. 4, lines 28-29 & col. 5, lines 43-47). It is beneficial to control the final gap. The gap is controlled to about 5 mm in size (col. 7, lines 23-38). Kitahama et al. does not teach workholders or clamping (brake).

Bischofberger et al. discloses a seam welding machine for sheet blanks. Clamping blocks clamp each block, both with an upper and lower clamp (abstract). An electrical resistance roller is used for mash seam welding (plastic deformation seam welding). Sheet blanks are pushed into a

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gap area (col. 2, lines 54-68, col. 3, lines 40-43 & col. 4, lines 1-25). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the blocks for clamping and holding, as taught by Bischofberger et al. in the Kitahama et al. system because the sheets have to be supported and aligned during processing.

Intended use has been continuously held not to be germane to determining the patentability of the apparatus, In re Finsterwalder 168 USPQ 530.

*Allowable Subject Matter*

3. Claims 12-22, 29 & 34-35 are allowed.
4. The following is an examiner's statement of reasons for allowance: the prior art does not teach a spherical shaped roller.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

5. Claims 25-26, 31-32, 39 & 41-42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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6. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach a gap sensing/tracking device.

*Response to Amendment*

7. Upon carefully reviewing Applicant's arguments filed March 31, 2003 the Examiner acknowledges the amendments to claims 11-12, 27, 29 & 33-34 and the addition of claims 36-42. The objections to claims 12-22, 29 & 34-35 are withdrawn in view of applicant's amendments.

8. Applicant's arguments filed March 31, 2003 (paper # 7) have been fully considered but they are not persuasive.

Applicant argues that Kitahama et al. does not teach welding. The examiner respectfully notes that "Intended use has been continuously held not to be germane to determining the patentability of the apparatus, In re Finsterwalder 168 USPQ 530". Additionally, Bischofberger et al. teaches welding of sheet products. Furthermore, unobviousness cannot be established by attacking the references individually when the rejection is based on a combination of art. In re Novak 16 USPQ 2d 204, 2043 (Fed. Cir., BPAI 1989); In re Merck & Co. 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); In re Keller 208 USPQ 871 (CCPA 1981); *Ex parte Varga* 189

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USPQ 204; *Ex parte Campbell* 172 USPQ 91; In re Scheckler 168 USPQ 716 (CCPA 1971); In re Young 159 USPQ 725; In re Lyons 150 USPQ 741.

### *Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

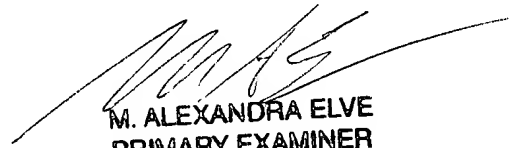
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Alexandra Elve whose telephone number is (703) 308-0092. The examiner can normally be reached Monday to Friday from 6:30 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn, can be reached on (703) 308-33318.

Any inquiry of general nature to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-0661.

  
M. ALEXANDRA ELVE  
PRIMARY EXAMINER

May 12, 2003.